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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/640,288	08/16/2000	Timothy S. Ehrlich	TN75A	3297

7590

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Rocco L Adormato  
Unisys Corporation  
Township Line & Union Meeting Roads  
Unisys Way  
Blue Bell, PA 19424

EXAMINER

NAJJAR, SALEH

ART UNIT PAPER NUMBER

2157

DATE MAILED: 02/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/640,288

Applicant(s)

EHRlich ET AL.

Examiner

Saleh Najjar

Art Unit

2157

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 16 October 2000.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 25-54 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 25-54 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All   b) ☐ Some \*   c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2,4 .                      6) ☐ Other: \_\_\_\_\_

1. This action is responsive to the preliminary amendment filed on October 16, 2000. Claims 1-24 were canceled. Claims 25-54 are newly added. Claims 25-54 are pending. Claims 25-54 represent method and apparatus for software features synchronization between software systems.

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 25-54 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-24 of U.S. Patent No. 6,161,135. Although the conflicting claims are not identical, they are not patentably distinct from each other because the missing features in the independent claims can be found in the dependent claims.

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 25, 27, 33, 39, 41, 47, and 53 are rejected under 35 U.S.C. 102(e) as being anticipated by Carter et al., U.S. Patent No. 6,519,767.

Carter teaches the invention as claimed including a compiler and method for automatically building version compatible object applications (see abstract).

As to claim 25, Carter teaches a computer system including software program entities having features providing specific functionality, at least one of said features requiring mutual support of at least two of said software program entities in order for the features to operate properly, said computer system being subject to introduction of new features, said software program entities being subject to new releases to support said new features, said software program entities including a first and second software program entity, a feature exchange method comprising:

storing, associated with said first software program entity, first indications of features supported by said first software program entity that require mutual support of said second software program entity, each of said features requiring mutual support of both said first and second software program entities in order to operate properly (see figs. 1-6; col. 7-8, Carter discloses that version compatibility analyzer detects incompatible differences between new and old object server programs);

storing, associated with said second software program entity, second indications of features supported by said second software program entity that require mutual support of said first software program entity, each of said features requiring mutual support of both said first and second software program entities in order to operate properly, comparing said first and said second indications with respect to each other (see figs. 1-6; col. 7-8; col. 13, Carter discloses that version compatibility analyzer detects incompatible differences between new and old object server programs by comparing source data with existing object server's type library); and

taking an appropriate action if said first indications include an indication of a feature not included in said second indications and taking said appropriate action if said second indications include an indication of a feature not included in said first indications, said appropriate action taken so as to prevent improper operation of said computer system due to installation of a release of one of said first and second software program entities that supports a particular feature requiring mutual support of the other of said first and second software program entities, where a release of said other of said first and second software program entities supporting said particular feature has not been installed (see figs. 1-6; col. 7-8; col. 13, Carter discloses that version compatibility analyzer detects incompatible differences between new and old object server programs by comparing source data with existing object server's type library).

As to claim 27, Carter teaches the method of Claim 25 wherein said appropriate action comprises stopping operation of said computer system (see col. 6-13).

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As to claim 33, Carter teaches the method of claim 25, wherein said first software entity comprises a operating system (see col. 2-6).

Claims 39, 41, 47, and 53 do not teach or define any new limitations above claims 25, 27, 33 and therefore are rejected for similar reasons.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Saleh Najjar whose telephone number is (703) 308-7613. The examiner can normally be reached on Monday-Friday from 6:30 to 3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, *Ario Etienne*, can be reached on (703) 308-7562.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-9600. The central official fax number for the group is (703) 872-9306.

A handwritten signature in black ink, appearing to read 'Saleh Najjar', with a stylized, flowing script.

Saleh Najjar

Primary Examiner / Art Unit 2157